

REMARKS

Applicant has received and carefully reviewed the Office Action mailed May 22, 2007. Reconsideration and allowance of the pending claims are respectfully requested.

Rejection under 35 U.S.C. § 103(a)

Claims 1-4, 6-12, 14-18, and 23-32 are rejected as being unpatentable over Davison (US 6,530,926) in view of Cornwall et al. (US 6,485,518). Claims 19-22 are separately rejected as being unpatentable over Davison in view of Cornwall et al. Applicant respectfully traverses the rejections. In response to Applicant's previous arguments, the Examiner asserts that Cornwall teaches a screw or fixation device going through a first vertebrae and into a second one, and that to perform this procedure, access to the spinal area would have been required, regardless of triangulation, Cornwall would ultimately fix two vertebrae relative to one another. The Examiner appears to be asserting that one of ordinary skill in the art would disregard the teachings of Cornwall for inserting screws at angled orientations using the narrow cannula to achieve the advantages provided by triangular support. Cornwall appears to teach specific advantages achieved by the triangular positioning of the screws and bone implants, using the recited narrow cannula. See column 1, line 66 through column 2, line 67. Further, Cornwall teaches their method of using facet screws and bone allografts as providing advantages over prior methods involving pedicle screws. See column 3, lines 32-40.

The example methods and systems disclosed in Davison directed at using an expandable elongate body for inserting separate fasteners into separate vertebrae and then using a fixation element to connect the fasteners appear to be quite different and involve different method steps and equipment than the method of Cornwall. In particular, Cornwall teaches, "the present narrow bone allografts are more easily inserted into the patient through a (narrower) cannulated passageway." See column 2, lines 47-49. Cornwall then teaches, "[m]ost preferably, the placement of facet screws 30A and 30B is carried out using the same guideframe as was used to position the bone allografts," and "cannula 72 is angled to facilitate the positioning of one of facet screws 30 therethrough in a transfacet approach." See column 7, lines 13-15 and 26-28 and FIGS. 3-4. Cornwall thus appears to teach a preferred method

and system involving inserting 2 facet screws, where each screw is inserted through a separate narrow cannula at a specific angle through two vertebra.

As discussed in the previous response, at page 10, third paragraph, it would appear that if an enlarged/expandable elongate body, as discussed in Davidson, were used in the method disclosed in Cornwall, it would defeat the purpose of Cornwall's specifically oriented guideframes that orient narrow cannulae to deliver narrow implants to specific locations at specific orientations. In other words, Cornwall thus appears to teach away from replacing their narrow cannula in the facet screw placement procedure with the enlarged/expandable elongate body, as discussed in Davidson. The Examiner has not responded to this argument presented in the previous response. If this rejection is maintained, the Examiner is respectfully requested to provide a response in the next office action.

Further, there does not appear to be any motivation or suggestion for one of ordinary skill in the art to attempt to perform the method of Davison by substituting the step of Cornwall of inserting a single screw through two vertebrae in order to provide transfacet fixation for keeping the vertebrae from moving relative to one another, as asserted by the Examiner. Davison already teaches a method of fixing adjacent vertebrae such that they do not move relative one another, using separate screws for each vertebrae and a fixation member to join the screws. Each of Davison and Cornwall appear to teach different methods and apparatus for fixing two vertebrae. The Examiner has not provided any reasoned statements or specific motivation from a reference as to why one of ordinary skill in the art would have been motivated to modify the method of Davison by using the single screw of Cornwall. Additionally, as discussed above, such a modification would appear to frustrate the purpose of Cornwall. The Examiner has thus not met the burden of establishing a *prima facie* case of obviousness.

MPEP 2143.01 III states, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)... Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.' 916 F.2d at 682, 16 USPQ2d at 1432.)." The Examiner appears to be asserting that one of

ordinary skill in the art could modify the methods of Davison and/or Cornwall to achieve the methods as claimed, however, such assertion cannot support an obviousness rejection.

Applicants also respectfully point out that dependent claim 10 recites the added step of delivering a second fastener through the same access device used to deliver the first fastener, where the second fastener is advanced through the first vertebra and into the second vertebra. Independent claim 23 recites delivering first and second fastener through a single access device to first and second surgical locations, respectively. The Examiner has not addressed these claims. Cornwall appears to teach advancing first and second screws into first and second vertebrae through separate cannulas at specific different angles. See column 7, lines 9-28. Davison appears to teach inserting a single screw in each of two or more vertebra and then connecting the screws using a fixation member. Neither Davison nor Cornwall appear to teach or suggest each and every element of claims 10 and 23. Thus, even if one were to combine Davison and Cornwall, one would not arrive at the methods as claimed. MPEP 2143.03 states:

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988).

If this rejection is maintained, Applicant respectfully requests the Examiner provide a detailed explanation of the rejection of claims 10 and 23. For at least the reasons set forth above, the Examiner has failed to establish a *prima facie* case of obviousness. Reconsideration and withdrawal of the rejections are respectfully requested.

Claims 5 and 13 are rejected as being unpatentable over Davison (US 6,530,926) in view of Cornwall et al. (US 6,485,518) as applied to claims 1 and 8 and further in view of Naubardt (US 5,196,015). As discussed above, Davison and Cornwall cannot be combined to arrive at the invention of independent claim 1, from which claims 5 and 13 depend. Naubardt does not appear to provide what Davison and Cornwall lack - Naubardt does not appear to

provide any motivation or suggestion for modifying Davison and/or Cornwall to achieve the method steps recited in independent claim 1, or dependent claims 5 and 13. Reconsideration and withdrawal of the rejection are respectfully requested.

Reconsideration and reexamination are respectfully requested. It is submitted that, in light of the above remarks, all pending claims are now in condition for allowance. If a telephone interview would be of assistance, please contact the undersigned attorney.

Respectfully submitted,

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By his attorney,

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